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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,328	09/24/2001	Itsuo Fujiwara	0649-0804P-SP	5333

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 01/27/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n No.</b>		<b>Applicant(s)</b>	
	09/960,328		FUJIWARA ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Thorl Chea		1752	

-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --  
**Period f r Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 are is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fails to provide support for the newly amended language "(w)ith the proviso that the oxazoline compound is not oxazolidine". Thus, this language constitutes new matter to the specification.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi et al (Hirabayashi).

Hirabayashi suggests the use of oxazoline compound in column 8, lines 20-25 in a photothermographic material containing photosensitive silver halide, an organic silver salt, reducing agent and binder (abstract). Therefore, Hirabayashi renders the invention

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as claimed prima facie obvious. Therefore, the reference suggests and makes obvious the claimed subject matter. In re Malagari, 182 USPQ 549.

5. Claims 2-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Hirabayashi et al (Hirabayashi) and Koyama et al (Koyama).

The teaching of Hirabayashi is as taught in the paragraph 4 above. Moreover, the compound having 2-oxazolyl group has been taught in Koyama in column 2 formula A. In column 10, lines 13-30, it is disclosed that the compound is useful in a variety of recording material including thermal sensitive image forming material and silver halide photographic light-sensitive material in term of producing an information recording medium having high resistivity to damage formed before, during and after processing. It would have been obvious to include the compound taught in Koyama in the material of Hirabayashi for same reason, and thereby provide a material as claimed.

#### ***Response to Arguments***

6. Applicant's arguments filed November 13, 2002 have been fully considered but they are not persuasive.

It is the Examiner's position that the invention in claim 1 is still prima facie obvious over Hirabayashi et al because of Hirabayashi in column 8 discloses the use of oxazolidine as antifoggant in heat photosensitive material, and the use thereof in any layer forming a heat photosensitive developable material to improve its fogging property would have been found obvious to the worker of ordinary skill in the art.

It is the Examiner's position that the claimed invention is still prima facie obvious over the combination of Hirabayashi and Koyama for the reason set forth in the rejection

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above. Koyama in column 4 discloses a polymer such as "poly(2-isopropenyl-2-oxazolidine) in the subbing layer to improve adhesive property of a recording layer to a support including thermal sensitive forming material. This polymer contains more than one oxazolidine group since the term "poly" encompasses the scope of more than one. The limitation of "at least one layer constituting said photothermographic material" presented in the claimed invention encompasses any layer forming a photothermographic material including a subbing layer known to improve the adhesive property of the support. The specification disclosure fail to clearly define the scope of the layer constituting the photothermographic material. Thus, the scope of at least one layer constituting the photothermographic material including any layer other than image forming layer. The results presented in the argument and in the specification disclosure such as the low  $\Delta_{min}$  is related to the use of the polymeric compound containing 2-oxazoline monomer in the image forming layer and the interlayer adjacent to the image forming layer. The scope of the invention in claim 1 is directed to the use of the "oxazoline compound" which encompasses the scope of oxazoline compound taught in Hirabayashi in column 8, lines 23, wherein the oxazoline compound serves as an antifoggant, and it would have been expected by the skill of ordinary skill in the art that the use thereof would improve the  $\Delta_{min}$  of photothermographic material.

It is noted that the invention as claimed is related to the use of the "oxazoline compound" in claim 1 and the use of Oxazoline compound having two or more 2-oxazoline groups in claim 2. The invention in claim 1 would have been found obvious to Hirabayashi alone since it teaches the oxazoline compound as antifoggant; whereas the

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invention in claim 4 is obvious over the combination of Koyama. The invention in claim 4 would be overcome over the prior art of record if limited to the use of the polymeric compound containing two or more 2-oxazoline groups in the image forming layer since Koyama does not teach the use thereof in the image forming layer. However, the invention in claim 1 is not patentably distinct from Hirabayashi.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9301 for regular communications and (703)872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

tchea *tlc*  
January 21, 2003



Thorl Chea  
Primary Examiner  
Art Unit 1752